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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,204	06/30/1999	ROLAND DE LA METTRIE	05725.0398	2598

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/319,204

Applicant(s)

DE LA METTRIE ET AL.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 9-30-03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 15-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 15-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The following grounds of rejection are maintained as applied in the previous office action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 75-97 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,241,784. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the claims of the patent are directed to compositions containing the same oxidation dyes, couplers, 2-electron oxidoreductase enzymes and donors for said enzymes as herein claimed. The patent claims differ from the instant claims in that the patent claims require at least one nonionic guar gum. Since applicant's claims are in comprising terms, this patent would anticipate the instant claims were it available as prior art.

Claims 75-97 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,342,078. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims cover compositions which overlap the instant compositions as the same oxidation bases and couplers are claimed in compositions with 2-electron oxidoreductase enzymes and donors for said enzymes. The patent claims differ from the instant claims because the patent claims claim that the composition also comprises water or an organic solvent. It would have been obvious to the skilled artisan that the claims are clearly analogous as it is notoriously well known that oxidation hair dyeing compositions are dissolved in a solvent and that said solvent is always an aqueous one.

Response to Arguments

Applicant has argued that the examiner must compare the claims of the instant application to the claims of the two patents respectively. That is exactly what the examiner did. See the above rejections which are based on the claims of each patent. Below is a specific example of a comparison of claims which would extend applicant's rights:

Claim 77 of this application requires;

- An oxidation base selected from a long laundry list including p-phenylenediamines
- An oxidation base selected from p-aminophenols

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- A m-aminophenol coupler
- At least one 2-electron oxidoreductase
- At least one donor therefor

Regarding US 6,241,784, claim 1 as modified by claims 19 and 21 claims a composition comprising:

- an oxidation base chosen from the laundry list including p-phenylenediamine in claim 77 above and additionally p-aminophenols- see claim 19
- a m-aminophenol coupler- see claim 21
- At least one 2-electron oxidoreductase
- At least one donor therefor

Regarding US 6,342,078, claim 1 modified by claims 15 claims a composition comprising:

- At least one oxidation base chosen from p-phenylenediamines, p-aminophenols, etc or mixtures thereof
- A m-phenylenediamine coupler
- At least one 2-electron oxidoreductase
- At least one donor therefor

Accordingly, since the patents includes compositions as claimed herein, the double patenting rejections must be maintained.

The rejection of claims 75-97 under 35 U.S.C. 103(a) as being unpatentable over Cotteret et al., US 5,514,188 in view of Tsujino, 4,961,925 has been overcome by the declaration of Gregory Plos which shows that replacing the hydrogen peroxide system of Cotteret with the 2-electron oxidoreductase system as claimed results in unexpectedly increased chromaticity. Since the rejection was based on the premise that equal dyeing would result, the rejection is overcome.

The rejection of claims 75-99 under 35 U.S.C. 103(a) as being unpatentable over Brody et al., US 3,884,627 in view of Tsujino, US 4,961,925 has been overcome by the declaration of Gregory Plos which shows that replacing the hydrogen peroxide system of Brody with the 2-electron oxidoreductase system as claimed results in unexpectedly increased chromaticity. Since the rejection was based on the premise that equal dyeing would result, the rejection is overcome.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

December 18, 2003


Margaret Einsmann
Primary Examiner
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